

REMARKS

Claims 1-27 are pending and at issue in this application. Claims 1-7, 13-16, 23 and 24 are rejected as obvious over a combination of Tung et al. (U.S. Patent No. 5,803,498), Yuyama et al. (U.S. Patent No. 5,839,836) and Griffiths et al. (5,435,600). Claims 8 and 17 are rejected as obvious over Tung et al., Yuyama et al. and Griffiths et al., in further view of Richardson (U.S. Patent No. 6,161,871). Claims 10 and 19 are rejected as obvious over Tung et al., Yuyama et al. and Griffiths et al., in further view of Bellesfield et al. (U.S. Patent No. 6,282,489). Claims 9 and 18 are rejected as obvious over Tung et al., Yuyama et al. and Griffiths et al., in further view of Lourette et al. (U.S. Patent No. 6,515,760).

Reconsideration is requested in light of the following remarks.

Claims 10 and 19 are amended to recite location-specific data associated with a selected medication. No new matter is added by these amendments.

Applicant respectfully traverses the rejection of claims 1-7, 13-16, 23 and 24 as obvious over Tung et al., Yuyama et al., and Griffiths et al. Each of the pending claims recites a method of or a system for providing duplex pharmacy labels comprising a sheet having a pair of peel-off labels disposed on a first area of an obverse face, a printer having an input arranged to receive the sheet and print on both faces of the sheet, a database including patient specific data and medication specific data, and a controller operatively connecting the printer and the database and arranged to cause the printer to print patient specific data for a selected patient and medication specific data for a selected medication.

It is clear that the prior art must make a suggestion of or provide an incentive for a claimed combination of elements to establish a *prima facie* case of obviousness. *See, In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973

(Bd. Pat. App. 1985). This principle holds true even if the applied art could be modified to produce the invention recited by the pending claims. *See, In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") Because none of Tung et al., Yuyama et al., or Griffiths et al. provides a motivation or suggestion to combine or modify any of the their teachings to produce the claimed combination, none of Tung et al., Yuyama et al., and Griffiths et al. can render any of the pending claims obvious.

While Tung et al. recites a sheet having separable segments, including a peel-off label, Tung et al. does not disclose a printer, a database, or a controller arranged to cause the printer to print patient specific data for a selected patient on both sides of a sheet. The office action acknowledges this deficiency and instead, cites Yuyama et al. and Griffiths et al. for the missing elements. While Yuyama et al. discloses a printing apparatus for printing patient specific warning information on a medicine bag, Yuyama et al. provides no motivation or suggestion for modifying or combining its teaching with those of Tung et al. or Griffiths et al. to produce the claimed label. Specifically, Yuyama et al. teaches away from the claimed combination. The Yuyama et al. apparatus is specifically designed to print information on a medicine bag or an insert as part of a medicine bag where both the medicine bag and insert material is formed from sheet roll material. In fact, Yuyama et al. discloses a single device containing both the medicine bag forming unit and a printing unit. Because Yuyama et al. is primarily concerned with printing cautionary drug information on or with a newly formed medicine bag, Yuyama et al. actually teaches away from duplex printing a sheet having peel of labels, as recited by the pending claims. If Yuyama et al. is used to print directly on a medicine bag, then Yuyama et al. teaches away from duplex printing because it would defeat

the purpose of Yuyama et al. to print anything on the inside of a medicine bag, where Yuyama et al. is primarily concerned with providing readily visible caution information.

Furthermore, Yuyama et al. also teaches away from using a sheet having peel off labels because the purpose of using a peel off label is to attach the peel-off label to an intended object, such as a drug container. If Yuyama et al. is used to print cautionary information about the contents of a medicine bag, where the insert is formed as part of the medicine bag, then Yuyama et al. teaches away from using peel off labels because the cautionary information is already disposed within its intended target, i.e., the medicine bag and its contents. In other words, if the information is cautionary information relied upon to warn patients of the contents of a medicine bag, then there is no motivation to remove that cautionary information from the medicine bag and attach it to another object. It follows, therefore, that Yuyama et al. fails to provide any motivation or suggestion to be combined with a duplex printing device for printing on a sheet with peel off segments.

While Griffiths et al. discloses a duplex-printed folding sheet having two peel-off labels, Griffiths et al. fails to provide any motivation or suggestion, in any manner, to modify or combine its teachings to produce the claimed combination.

Furthermore, Tung et al. fails to disclose a motivation or suggestion to modify its own invention to produce the claimed combination or to modify or combine any of the elements taught in Yuyama et al. and Griffiths et al. to produce the claimed combination. Tung et al. discloses a sheet used in marketing for information collection regarding a specific drug. The Tung et al. sheet requires handwritten input on various segments of its sheet for the purpose of recording information for later collection. Specifically, it provides sections 6A, 10A, 20A which require patient specific data to be handwritten by a pharmacist or physician, including

a signature 30. Therefore, Tung et al. actually teaches away from a controller, database, and printer combination that prints patient specific data for a selected patient on a label.

Applicant further traverses the rejection of claims 5 and 15 as obvious over the combination of Tung et al., Yuyama et al., and Griffiths et al. Claims 5 and 15 recite a sheet having a pair of fold lines dividing the sheet into sections, and a first area disposed on a single section and containing a pair of peel-off labels. Tung et al. and Yuyama et al. fail to disclose any sheet having fold lines, and thus, the office action appears to rely on Griffiths et al. for such a teaching. However, while Griffiths et al. discloses a sheet having a pair of fold lines, Griffiths et al. fails to teach a first area having two peel-off labels being disposed on a single section, as defined by a fold line. Griffiths et al. discloses that its two peel-off labels 17 and 19 are separated by a fold line 24, and thus, Griffiths et al. fails to disclose a first area of a single section containing a pair of peel-off labels. Moreover, to be operable, Griffiths et al. requires that its two peel-off labels be symmetrically folded against each other to provide contact between the two labels for image transfer. Because Griffiths et al. cannot operate if its two peel-off sections are not disposed on different sides of a fold line, Griffiths et al. actually teaches away from the claimed combination. It follows, therefore, that no combination of Tung et al., Yuyama et al., and Griffiths et al. can render claims 5 and 15 obvious.

Applicant respectfully traverses the rejection of claims 8 and 17 as obvious over the combination of Tung et al., Yuyama et al., and Griffiths et al. in further view of Richardson. Each of dependent claims 8 and 17 recites, in part, that patient specific data and medication specific data are printed in landscape format on one of an obverse face and a reverse face of a sheet and in portrait format on the other of the faces. The office action acknowledges that none of Tung et al., Yuyama et al., and Griffiths et al. discloses that patient specific data and

medication specific data are printed in landscape format on one of an obverse face and a reverse face of a sheet and in portrait format on the other of the faces, and instead relies on Richardson for such as disclosure. However, while Richardson discloses a greeting card that prints on a single face both a portrait and landscape format image, Richardson fails to disclose patient or medication specific data and further fails to disclose an obverse face and reverse face of a sheet. Specifically, Richardson does not teach any pharmaceutical application at all and the obverse face and reverse face of Richardson are shown to contain similarly oriented images (see Figs. 2 and 3). Therefore, no combination of Tung et al., Yuyama et al., Griffiths et al., and Richardson can render claims 8 and 17 obvious.

Applicant respectfully traverses the rejection of claims 10 and 19 as obvious over the combination of Tung et al., Yuyama et al., and Griffiths et al. in further view of Bellesfield et al. As amended, claims 10 and 19 recite a database including location-specific data associated with a selected medication for a plurality of store locations and a controller arranged to forward the location-specific data associated with the selected medication to a printer. The office action acknowledges that none of Tung et al., Yuyama et al., and Griffiths et al. discloses any location-specific data for a plurality of store locations, much less location-specific data associated with a selected medication. Bellesfield et al. also fails to disclose location-specific data associated with a selected medication, in any manner, and thus, no combination of Tung et al., Yuyama et al., Griffiths et al. and Bellesfield et al. can render pending claims 10 and 19 obvious.

Applicant respectfully traverses the rejection of claims 9 and 18 as obvious over the combination of Tung et al., Yuyama et al., and Griffiths et al. in further view of Lourette et al. Claims 9 and 18 disclose that at least a portion of medication specific data on a reverse face of a sheet is printed in landscape format and extends across a first area and partially

across a second area of the reverse face. The office action acknowledges that none of Tung et al., Yuyama et al., and Griffiths et al. discloses medication specific data printed in landscape format across a first area and partially across a second area of a reverse face of a sheet. Lourette et al. also fails to disclose medication specific data printed across a first and second area of a sheet because Lourette et al. fails to disclose a sheet, in any manner. Instead, Lourette et al. discloses sections of digital images on a monitor. Moreover, Lourette et al. fails to disclose any medical information, much less patient specific information or medication specific information. It follows that no combination of Tung et al., Yuyama et al., Griffiths et al. and Lourette et al. can render pending claims 9 and 18 obvious.

CONCLUSION

Applicant submits that this case is in a condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and allowance of rejected claims 1-27.

If there are matters that can be discussed by telephone to further the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number listed below.

Dated: December 22, 2005

Respectfully submitted,

By 
David C. Read

Registration No.: 39,811
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant